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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 27 2005

IN RE APPLICATION

OF: TAKAGI ET AL.

SERIAL No. 10/019,481

FILED: APRIL 04, 2002

FOR: ANT CONTROLLERS AND METHOD FOR APPLICATION THEREOF

ATTY. DOCKET: AM100246-00

CONFIRMATION No.: 1417

GROUP ART UNIT: 1616

EXAMINER: NEIL S. LEVY

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09/28/2005 TL0111 00000019 141437 10019481

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REQUEST FOR CONTINUED EXAMINATIONPRELIMINARY SUBMISSION

Sir:

This is a Request for Continued Examination pursuant to 37 C.F.R. §1.114 which is filed in response to the final Office action of April 05, 2005. For further prosecution, kindly enter and consider the following preliminary remarks and the attached test report:

PRELIMINARY REMARKS

Claims 1, 10 and 13 to 17 as presented by applicants in their reply dated March 02, 2004, are currently pending in this case. Claim 15 stands withdrawn from consideration by the Examiner and Claims 1, 10, 13, 14, 16 and 17 stand rejected.

The Examiner argued that Claim 15 was drawn to an invention which was independent or distinct from the invention originally claimed and

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that the claim need therefore not be considered by him under the U.S. rules and regulations. It is respectfully noted that the present application is a national stage application filed under Section 371. Accordingly, the U.S. rules and regulations which are applicable in the present case are consonant with the provisions of PCT Article 27.1 which sets forth that no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in the PCT and its Regulations. Under the PCT and its Regulations, and accordingly under the U.S. rules and regulations which govern national stage applications, the question whether a claim in an application has to be considered by the Examiner is not whether the claim defines an independent and/or distinct invention or whether the claim was originally presented in the national stage application. Rather, the question is whether the claims which are in the application at any stage of the proceedings meet the requirements of unity of invention which are set forth in PCT Rule 13. The Examiner's withdrawal of Claim 15 from consideration in this application is, in light of the foregoing, deemed to be in error. It is respectfully requested that Claim 15 be rejoined. Favorable action is solicited.

The Examiner rejected Claims 1, 10, 14, 16 and 17 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable in light of, the teaching of *Harrison et al.* (WO 92/06076) or the teaching of *Toki et al.* (EP 0 500 111). In particular, the Examiner stated that the language of applicants' claims was sufficiently open and generic to encompass and be anticipated by the referenced teachings.

Applicants' claims relate to certain methods in which particular pests, namely

- a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders;¹⁾
- a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families;²⁾ and
- a pest from the Formicidae family;³⁾

are controlled by applying an effective amount of a specific hydra-

1) Cf. Claims 1, 10, 13 and 14.

2) Cf. Claim 15.

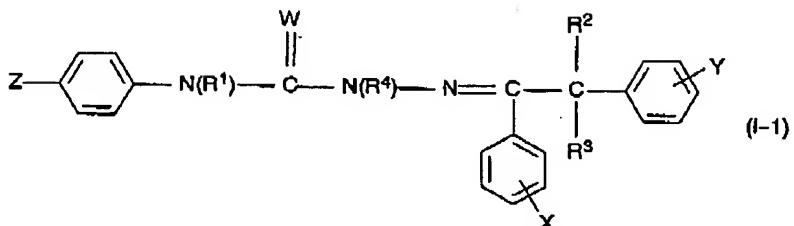
3) Cf. Claims 16 and 17.

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zine compound of formula (I-1)



which, *inter alia*, requires that Y represent from 1 to 5 identical or different substituents selected from the group consisting of nitro and cyano.⁴⁾

Neither the teaching of *Harrison et al.* nor the teaching of *Toki et al.* disclose any compounds which fall within the realm of applicants' formula (I-1). While the generic information which is provided by *Harrison et al.* or by *Toki et al.* allows that specific radicals and structural requirements are selected and combined to recreate applicants' formula (I-2), neither one of the references provides any information which would have guided a person of ordinary skill in the art to make the requisite selection and combination. In fact, *Toki et al.* even lead away from the selection and combination which is necessary to arrive at the compounds which are employed in applicants' method, when they state that the radical(s) corresponding to applicants' moiety Y be preferably hydrogen; halogen; optionally substituted alkyl, alkoxy, alkylthio and carboxyl; or $X^5SO_3^-$.⁵⁾

The teachings of *Harrison et al.* and of *Toki et al.* are equally broad and unspecific where the effectiveness of their compounds against pests is concerned. The spectrum of pests addressed by *Harrison et al.*, for example, encompasses rodents as well as Lepidoptera, Coleoptera, Hemiptera, Homoptera, acari, Orthoptera, Diptera, Thysanoptera, Hymenoptera, Isoptera and Siphonoptera.⁶⁾

Applicants already urged that anticipation under Section 102 can be found only if a reference shows exactly what is claimed.⁷⁾ The test for anticipation is one of identity, and the identical invention must

4) Cf. e.g. Claims 1, 15 and 16.

5) Cf. the information on page 5, indicated lines 30 to 42, of EP 0 500 111; regarding the groups R³ and R⁴ of *Toki et al.*'s formula (I).

6) Cf. page 53, indicated line 10, to page 55, indicated line 35, of WO 92/06076; and the corresponding enumeration on page 38, indicated line 46, to page 39, indicated line 14, of EP 0 500 111.

7) Cf. Titanium Metals Corp. v. Bannex, 778 F.2d 775, 227 USPQ 773 (CAFC 1985); In re Marshall 577 F.2d 301, 198 USPQ 344 (CCPA 1978); In re Kalm 378 F.2d 959, 154 USPQ 10 (CCPA 1967).

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be shown in the reference in as complete detail as is contained in the claim.⁸⁾ In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning.⁹⁾ The teachings of *Harrison et al.* and of *Toki et al.* clearly fail to show an method in which an effective amount of a compound which meets the structural requirements of applicants' formula (I-1) is employed to control

- a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders;
- a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families; and
- a pest from the Formicidae family;

as is required in accordance with applicants' claims. Under the standards developed by the Courts, the teaching of *Harrison et al.* and the teaching of *Toki et al.* cannot reasonably be taken to anticipate the subject matter of applicants' claims. It is therefore respectfully requested that the respective rejection under Section 102(b) be withdrawn.

It is also respectfully submitted that under the standards developed by the Courts regarding obviousness under Section 103(a), the teachings of *Harrison et al.* and/or *Toki et al.* are insufficient to render applicants' methods *prima facie* obvious. Obviousness within the meaning of Section 103(a) requires more than the mere possibility to make a selection from the generic disclosure of a reference which mirrors the combination of requirements set forth in an applicant's claim. The reference also has to provide some teaching or suggestion which would motivate a person of ordinary skill in the art to make the particular selection which results in the claimed combination.¹⁰⁾ Also, when determining whether a claimed method is obvious within the meaning of Section 103(a), not only the materials used and the nature of the specific process employed but also the particular result which

8) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989).

9) Cf. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (CAFC 1984).

10) Cf. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991). See also *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (CAFC 1994); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (CAFC 1992).

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is obtained must be considered.¹¹⁾ Where the motivating teaching or suggestion is not found in the reference, any possible selection and combination within the generic disclosure is equally likely and the reference is no more than an invitation to make and try out each of the possible selections and combinations. "Obvious to try" is, however, not a proper basis for finding that a claimed invention is unpatentable under Section 103(a).¹²⁾ Also, where the prior art fails to suggest or imply the desirability of the particular selection and combination which is necessary to arrive at the claimed invention, any focus on the requirements of the claims in the generic disclosure of the prior art would be solely guided by the applicants' invention and would, therefore, be based on hindsight.¹³⁾

Applicants' invention is based on the finding that compounds of formula (I-1) in which Y represent from 1 to 5 identical or different substituents selected from the group consisting of nitro and cyano are particularly suited to control

- a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders;
- a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families; and
- a pest from the Formicidae family;

in certain environments. The compounds of applicants' formula (I-1) are significantly more effective against the referenced pests and applicants' method has, therefore, distinct advantages over the methods which are addressed in the referenced teachings. The unexpected superiority of applicants' methods is illustrated by the data set forth in the Test Report which is enclosed with this paper. Although the data are currently not presented in form of a properly executed Declaration, it is respectfully submitted that the data contained in the Test Report is entirely reliable. Moreover, a properly executed Declaration setting forth the experiments and data described in the Test Report is currently being prepared, and the executed Declaration will be forwarded to the Patent and Trademark Of-

11) Cf. In re Dillon, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (CAFC 1990) (*en banc*), cert. denied, 500 U.S. 904 (1991).

12) Cf. Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (CAFC 1989) where the Court held that an invention was merely "obvious to try" if the prior art gives either no indication of which parameters are critical or no direction as to which of the many possible choices is likely to be successful.

13) Cf. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (CAFC 1988)

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fice as soon as it becomes available. In their comparative investigations, applicants' employed a compound "II" which is unsubstituted in the position of the moiety "Y" of applicants' formula (I-1) as a representative for the compounds which are addressed in the teachings of *Harrison et al.* (D1) and of *Toki et al.* (D3). The results of the investigations show that the compounds of applicants' formula (I-1) are, in each case, by far and significantly more effective against the treated pests than the comparative compound "II".

Neither the teaching of *Harrison et al.* nor the teaching of *Toki et al.* contain anything which suggests or implies that the nature of the substituent(s) corresponding to the moiety "Y" of applicants' formula (I-1) is of any significance with regard to a successful control of the host of pests enumerated in the references. Moreover, neither the teaching of *Harrison et al.* nor the teaching of *Toki et al.* suggest or imply that introducing from 1 to 5 identical or different substituents selected from the group consisting of nitro and cyano in the position signified by the moiety "Y" of applicants' formula (I-1) would render the compounds especially suited to control the particular pests referenced in applicants' claims. Accordingly, the teaching of *Harrison et al.* and the teaching of *Toki et al.* fall short from rendering applicants' methods *prima facie* obvious within the meaning of Section 103(a). Favorable reconsideration of the Examiner's position and withdrawal of the respective rejection is, therefore, respectfully solicited.

The Examiner further rejected Claims 1, 10, 13, 14 and 16 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Treacy et al.* (US 6,342,518). It is respectfully noted that the teaching of *Treacy et al.* does not qualify as prior art under Section 102(b) because US 6,342,518 was not patented more than one year prior to the date of applicants' application for patent in the United States. It is therefore respectfully requested that the respective rejection under Section 102(b) be withdrawn.

It is further respectfully urged that *Treacy et al.* fail to identically disclose a method in which effective amounts of a compound according to applicants' formula (I-1) are employed to control

- a pest selected from the Isoptera, Hymenoptera, Orthoptera and Psocoptera orders;
- a pest selected from the Rhinotermitidae, Termitidae, Kalotermitidae and Termopsidae families; and

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- a pest from the Formicidae family;
in certain environments. Claims 7 and 13 of Treacy et al. which are referenced by the Examiner in support for his position require contacting said insect with a synergistically effective amount of a combination of a ... compound of the formula (I) ... and an arylpyrrole insecticide of formula VI ...¹⁴⁾ and

applying to the foliage or stem of said plant a synergistically effective amount of a composition of claim 1¹⁵⁾

where the composition of claim 1 is the combination of the compound of formula (I) and the arylpyrrole of formula (VI). The respective claims of Treacy et al. therefore clearly fail to require that either the compound of the formula (I) or the compound of the formula (VI) be applied in effective amounts. It is merely required that the combination of the compounds (I) and (VI) be synergistically effective. The significance of this distinction is immediately apparent when the experiments and data provided by Treacy et al. are reviewed. The Examples which are described by Treacy et al. clearly show that a satisfactory control of the specific pests which are employed in those investigations is only achieved when the compounds (I) and (VI) are applied in combination with one another. It is further noted that the specific pests which are employed in Treacy et al.'s investigations differ from the pests which are addressed in applicants' claims. Under the standards developed by the Courts, the teaching of Treacy et al. is, therefore, also insufficient to anticipate the subject matter of applicants' claims within the meaning of Section 102. Favorable action is solicited.

In the event that the Examiner is of the opinion that further explanations or clarifications are necessary or desirable in this matter, applicants would greatly appreciate it if the Examiner would grant their representative the opportunity address such matters in a personal interview to facilitate the proceedings.

14) Cf. col. 11, indicated line 32, to col. 12, indicated line 13, of US 6,342,518, emphasis added.

15) Cf. col. 14, indicated lines 2 to 4, of US 6,342,518, emphasis added.

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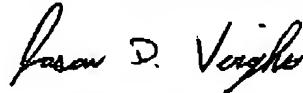
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. The respective \$1020.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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